



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,236	04/07/2000	Aviel D. Rubin	1999-0727	1307

7590 06/15/2004
Samuel H Dworetsky
AT&T Corp
P O Box 4110
Middletown, NJ 07748-4110

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
----------	--------------

2134

DATE MAILED: 06/15/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/544,236

Applicant(s)

RUBIN, AVIEL D.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-18 and 21-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the previous office action, Applicant has amended claims 1, 6, 10, 11, and 22; cancelled claims 19 and 20; and added claims 23 and 24. Claims 1-18 and 21-24 have been examined.

Drawings

2. The drawings were received on 3 May 2004. These drawings are not acceptable.

3. All previous objections to the drawings are withdrawn.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "130" in figure 3 has been used to designate both "BROADCAST PUB. KEY TO WORLD" and "INTERNET/BROADBAND NETWORK." Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

Art Unit: 2134

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. All previous objections to the specification are withdrawn.

Claim Objections

6. All previous claim objections are withdrawn.

Claim Rejections - 35 USC § 102

7. In view of applicant's amendments, all rejections under 35 U.S.C. 102 have been replaced by rejections under 35 U.S.C. 103.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-18, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,629,982 to Micali in view of U.S. Patent No. 5,633,916 to Goldhagen et al.

Regarding claims 1 and 2, Micali discloses an electronic transaction system in which electronic signatures are attached to return receipts are sent to "Alice," the calling party (see column 12, lines 23-34), which also certifies the identity of the recipient, "Bob." Micali further states that the mail system uses computer networks, which inherently transmit message as a set of digitized packets (see column 4, lines 58-65).

Micali discloses the use of his invention for telephone, fax, broadcast, or other communications networks (see column 4, lines 58-65), but does not explicitly specify that messages may be voice or multimedia mail.

Goldhagen discloses a system a universal messaging system, wherein both multimedia and voice messages may be sent (see column 6, lines 4-32), and suggests that the "Universal Mailbox Service" enables Windows/PC-based applications to perform all the functions currently available to telephone-based NAP Voice and Facsimile subscribers. Such messages, if transmitted digitally, comprise streams of packets.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Micali as a "Universal Mailbox Service," as disclosed by Goldhagen, in order to enable Windows/PC-based

applications to perform all the functions currently available to telephone-based NAP Voice and Facsimile subscribers.

As per claim 3, return certificates are being generated by the certification provider (the "Post Office").

As per claim 6, all such messages are being signed using an encryption key, E_A (see column 5, lines 10-20).

As per claim 9, Micali discloses that a signature may simply consist of a public key (see column 5, lines 30-35).

As per claim 10, Micali discloses that these are mail messages (see column 4, lines 49-52).

As per claims 11, 12, 14, the initial message sent by Alice to the Post Office is signed and includes a certificate (see column 11, line 62 to column 1, line 3).

As per claim 13, the Post Office acts as a judging system as well as a certifying system.

As per claims 21 and 22, Micali discloses that sessions may be initiated from telephones, faxes, etc., which would be off-network (see column 4, lines 59-62).

Regarding claims 4 and 5, the system disclosed by Micali does not incorporate a judging authority, but Micali discloses the use of a judging authority in a prior art system by Ben-Or et al., and further suggests that judging authorities reduce the probability that one party receives a contract, certifying the transaction, while the other does not.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Micali by adding a judging

authority, in order to reduce the probability that one party receives a contract, certifying the transaction, while the other does not.

Regarding claim 7, Micali discloses that the sender ("Alice") must indicate that she is using an ICM (return receipt) transaction (see column 11, line 66 to column 12, line 3), but does not state that she is prompted for that information.

Official notice is given that it well-known in the art that computer programs may prompt users when determining whether or not to employ an optional feature.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the invention of Micali by prompting Alice when determining whether or not to employ ICM, which is an optional feature.

As per claim 8, the return receipt received by Alice has been encrypted using Alice's key, and includes Bob's publicly verifiable signature (see column 4, line 66 to column 5, line 20 and column 12, lines 17-34), and is therefore verifiable by Alice.

Regarding claims 15 and 16, Micali discloses that Alice is a user, but does not discuss the network configuration being used by Alice.

Official notice is given that it is well-known in the art that in network communications, a user using a corporate network would be using a customer premises equipment system.

Official notice is also given that in corporate networks, it is well-known in the art that proxy servers are used to isolate the internal network from unwanted network traffic.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further implement the invention of Micali by having Alice use a corporate network, which would be a customer premises equipment system, and to implant on the corporate network a proxy server, in order to isolate the internal network from unwanted network traffic.

Regarding claims 17 and 18, Micali does not specify the type of system on which the Post Office or judging authorities are implemented.

Official notice is given that network utilities that is well-known in the art that network utilities that are simultaneously available to a large number of users are implemented on servers, in order to allow for efficient, consistent service to all authorized users.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further implement the invention of Micali by using a server for the Post Office or judging authority, in order to allow for efficient, consistent service to all authorized users.

9. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,629,982 to Micali in view of U.S. Patent No. 5,633,916 to Goldhagen et al. as applied to claims 1 and 11 above, and further in view of U.S. Patent No. 6,327,656 to Zabetian.

NOTE: Zabetian was cited, but not relied upon, in the previous office action.

Micali and Goldhagen do not address the disposition of extraneous header information during the compilation process.

Zabetian discloses a document certification apparatus wherein the certification module strips headers from a message being processed, and further notes that any portion of a message that is not to be certified should be removed (see column 7, lines 7-13).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system of Micali and Goldhagen by stripping headers during message processing, as disclosed by Zabetian, since any portion of a message that is not to be certified should be removed.

Response to Arguments

10. Applicant's arguments filed 3 May 2004 have been fully considered but they are not persuasive.

Regarding Applicant's arguments that the cited art does not include a "stream" of packets (see Paper No. 7, pp. 11-12), it is noted that the specification of the instant application does not use that term either; however, the word "stream" does characterize both the sets of packets in the instant application and in the cited prior art. It is for this reason that this new limitation neither overcomes the cited art nor constitutes new matter.

In response to applicant's argument that making the messaging functionalities in one reference available to users of a system in a difference reference (see Paper No. 7, p. 12), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The merging of functionalities onto a single system is clearly advantageous, since it allows for the elimination of redundant hardware.

Regarding Applicant's argument that the devices specified by Micali do not are not "off network," it is noted that Applicant's specification defines POTS equipment communicating via the PSTN to be "off network" (see p. 13, lines 15-17).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2134

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday, Tuesday, Thursday, or Friday from 7:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306
Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Application/Control Number: 09/544,236

Page 11

Art Unit: 2134

MEH *MEH*

June 9, 2004